

under 35 U.S.C. §102(e) as being anticipated by both U.S. Patent No. 6,834,199 to Hyun and U.S. Patent No. 6,707,644 to Murphy.

Claims 5-6 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Chuang* in view of U.S. Patent No. 6,850,226 to Finke-Anlauff.

Argument in Support of Removal of Chuang as a Reference

Attached hereto is a Supplemental Declaration of Roger Jellicoe Under 37 CFR §1.131 (hereinafter “Jellicoe Supplemental Declaration”) which, when taken in combination with the Declarations of Roger Jellicoe and Damon Neagle submitted in response to the March 23, 2005 Office action, establishes conception of the claimed invention prior to May 28, 2003 (the effective date of *Chuang*), coupled with due diligence from May 28, 2003 to the date of filing of this application.

The Jellicoe Supplemental Declaration and supporting materials provide clear documentation that Mr. Jellicoe conceived all of the elements of the invention recited in claim 1. The documents included in Exhibit B to the Jellicoe Supplemental Declaration document all elements of the invention as claimed in claim 1. With respect to a display panel that displays characters in at least two orientations, see page 4 of Exhibit B (describing landscape and portrait display formats). All of the other elements of claim 1 are visible in the drawings included on pages 5-6 of Exhibit B, and are also described on pages 2 and 4 of Exhibit B.

With regard to the date of conception, the Jellicoe Supplemental Declaration establishes that the documents of Exhibit B were created prior to May 23, 2003. In paragraph 3 of the Jellicoe Supplemental Declaration, Mr. Jellicoe states that the

documents of Exhibit B were created and submitted to Motorola (his employer) prior to May 23, 2003. Redaction of dates in exhibits submitted in support of the conception date of an invention, coupled with a statement in a declaration that the date of conception is prior to the effective date of the reference in question is specifically approved as sufficient to establish a date of conception for the purposes of 37 C.F.R. §1.131. M.P.E.P. §715.07(II). Therefore, paragraph 3 of the Jellicoe Supplemental Declaration and Exhibit B are clearly sufficient to establish conception of the invention prior to May 23, 2003.

The critical period for diligence begins just before the effective date of the reference (May 23, 2003) and ends with a reduction to practice, either actual or constructive (in this case, no later than September 12, 2003). Hull v. Davenport, 90 F.2d 103, 105 (C.C.P.A. 1937); M.P.E.P. §2138.06. In the case of a constructive reduction to practice, diligence of an attorney in preparing and filing a patent application inures to the benefit of the inventor. M.P.E.P. §2138.06. The workload and availability of the attorney, illustrator and inventor and the size of the attorney's staff are factors to be considered when evaluating if with the attorney exercised "reasonable diligence" in preparing and filing an application. See, e.g., D'Amico v. Kioke, 347 F.2d 867, 871 (C.C.P.A. 1965). In addition, an attorney acts with reasonable diligence if he/she has a reasonable backlog of unrelated cases that he/she takes up in chronological order. Bey v. Kollonitsch, 866 F.2d 1024 (Fed. Cir. 1986).

In this case, the Applicant has provided ample evidence to support diligence. The attached Supplemental Declaration of Damon Neagle Under 37 CFR §1.131 (hereinafter "Neagle Supplemental Declaration") outlines, in substantial detail, Mr. Neagle's

“reasonable diligence” in preparing and filing this application. Mr. Neagle had a backlog of two utility patent applications and three design patent applications at the time the above-referenced application was assigned to him, which resulted in a delay of three weeks in taking up the application. Neagle Supplemental Declaration, ¶¶ 2-3. Mr. Neagle worked diligently on the above-referenced application from May 20, 2003 to June 11, 2003. Neagle Supplemental Declaration, ¶3-5. From June 12, 2003 to July 15, 2003, Mr. Neagle’s efforts were diverted to work on eighteen design patent applications having an urgent bar date (July 14, 2003). Neagle Supplemental Declaration, ¶6. On July 15, 2003, Mr. Neagle resumed work on the above-referenced application, and continued to work diligently until its filing on September 12, 2003. Neagle Supplemental Declaration, ¶¶7-15. Mr. Neagle’s diligence on the above-referenced application was reasonable, particularly when considered in view of his heavy workload during the critical period and in view of the fact that he was a solo practitioner with a minimal support staff. Neagle Supplemental Declaration, ¶¶16-17.

In view of the foregoing, Applicant has established conception and diligence regarding the above-referenced application. Accordingly, withdrawal of the rejections under 35 U.S.C. §102(e) and 103(a) based on *Chuang* is respectfully requested.

Rejection of claims 5-6 under §103(a) over *Chuang* in view of *Finke-Anlauff*

Even if *Chuang* had not been removed as a prior art reference, claims 5-6 are patentable over *Chuang* in view of *Finke-Anlauff*. Claim 4 is drafted to encompass at least two different configurations relating to movement of the display housing, first keypad housing and/or second keypad housing. In a first configuration falling within the

scope of claim 4, the first keypad housing is movable relative to the second keypad housing, and their respective paths of travel are different. An alternative configuration falling within the scope of claim 4, the first and second keypad housings are fixed relative to one another and the display housing is capable of being moved along two different paths of travel – one that exposes the first keypad and a second that exposes the second keypad.

The Examiner has not asserted, nor do any of the references of record teach, the alternative configuration discussed in the previous paragraph. Therefore, no further analysis of this configuration is warranted in this Reply.

With respect to the first configuration, neither *Chuang* nor *Finke-Anlauff* teaches or suggests movable keypads that move relative to each other along transverse paths of travel. The Examiner asserts that it would have been obvious to one of ordinary skill in the art to modify *Chuang* to have keypads that slide in transverse paths in view of *Finke-Anlauff's* teaching of a display screen that is viewable in two orientations. This is impermissible hindsight on the part of the Examiner. As explained in Applicant's Reply to the initial Office action, *Finke-Anlauff* does not disclose or suggest a movable keypad of any kind, much less keypads that move transversely to each other. In addition, *Chuang* itself discloses a display screen that is viewable in two orientations (see *Chuang*, paragraph 17). How can a teaching in *Finke-Anlauff* provide motivation to modify *Chuang* when that feature is already incorporated into *Chuang*? Therefore, *Finke-Anlauff* adds nothing to *Chuang*.

In view of the foregoing, claims 5-6 are allowable over the prior art of record, even if *Chuang* is not removed as a prior art reference.

Rejection of claims 1, 7, 8 and 13 under §102(e) over *Pekka*

As explained in Applicant's Reply to the initial Office action, claim 1 has been amended to incorporate the subject matter of dependent claim 9 (now canceled). In the initial Office action, the Examiner concluded that claim 9 (as originally presented) was patentable over *Pekka*. The Examiner now asserts that *Pekka* anticipates claim 1.

Pekka does not teach "a display panel that displays characters in at least two orientations," as required by claim 1. In the pending Office action, the Examiner asserts that FIGS. 3A-3G teach this limitation. To the contrary, there is nothing in FIGS. 3A-3G, or the description of these figures in the specification of *Pekka* that shows or states that any one of the display screens shown in FIGS. 3A-3G displays characters in more than one orientation. Therefore, withdrawal of the rejection of claims 1, 7, 8 and 13 over *Pekka* is respectfully requested.

Provided that *Chuang* is removed as a reference, withdrawal of the prior art rejection based on *Pekka* means that claims 2-8 and 10-13, which all depend from claim 1, are also allowable over the prior art of record.

Rejection of claims 24-26 under §102(e) over both *Hyun* and *Murphy*

Applicant respectfully traverses the rejection of claims 24-26 over both *Hyun* and *Murphy*. There are at least two limitations of claim 24, which are not taught or suggested by either *Hyun* or *Murphy*.

Claim 24 requires that the respective paths of travel of the first and second keypads be "transverse." The Examiner asserts that *Hyun* and *Murphy* disclose paths of

travel for their keypads that are “different” (see Office action page 7). The ordinary definition of the term “transverse” means “acting, lying, or being across” or to be “set crosswise.” In the context of claim 14, if two paths of travel are “set crosswise” or “lie across” each other, they must intersect. This is not the case in either *Hyun* or *Murphy*. In *Hyun*, the paths of travel of the first and second keypad housings 61, 62 cannot intersect because the keypads are co-planar and abut each other. See *Hyun*, FIGS. 9A-9C, Col. 6, lines 8-38. In *Murphy*, the paths of travel of the extendable keyboard sections 112, 122 are parallel, and therefore, never intersect. See *Murphy*, FIGS. 2-4. Therefore, neither *Hyun* nor *Murphy* teaches this limitation.

In addition, neither *Hyun* nor *Murphy* teaches a display panel that displays characters in two different orientations, as required by claim 24. The Examiner asserts such a teaching in the pending Office action, but does not provide any reference to the figures or descriptions of *Hyun* or *Murphy*. Based on Applicant’s representative’s review of *Hyun* and *Murphy*, neither reference teaches or suggests a display panel that displays characters in two different orientations. Moreover, the keypad configurations provided in *Hyun* and *Murphy* do not appear suitable for use with multiple display orientations. Therefore, withdrawal of the prior art rejections of claims 24-26 is respectfully requested. Should the Examiner refuse to withdraw these rejections, Applicant respectfully requests that the Examiner identify the relevant portions of *Hyun* and *Murphy* that teach the contested limitations of claim 24.

Claim 25 requires that the paths of travel of the keypads be linear. *Hyun* does not teach or suggest this limitation. *Hyun* teaches first and second keypad housings 61, 62 that pivot about respective hinges H1, H2. Therefore, the paths of travel of *Hyun*’s first

and second keypad housings 61, 62 are curved, not linear. See *Hyun*, FIGS. 9A-9C, Col. 6, lines 13-17. Accordingly, claim 25 further patentably defines over *Hyun*.

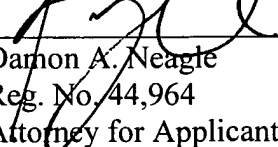
Claim 26 requires that the display, first keypad and second keypad “overlap and stack when the first and second keypads are both in a nested position.” *Hyun* does not teach or suggest this limitation. As explained above with respect to claim 24, *Hyun*’s first and second keypad housings 61, 62 abut one another and do not overlap. Therefore, *Hyun*’s first and second keypads 61, 62 do not overlap one another, as required by claim 26. See *Hyun*, FIGS. 9A-9C, Col. 6, lines 13-17. Accordingly, claim 26 further patentably defines over *Hyun*.

Additional Remarks

A minor amendment has been made to allowed claim 14 to correct a typographical error in the claim as originally presented.

Respectfully submitted,
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